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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,853	12/06/2000	James M. Hair III	PM 0271810	7885

7590 08/13/2003

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EXAMINER

LESTER, EVELYN A

ART UNIT PAPER NUMBER

2873

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,853

Applicant(s)

HAIR ET AL.

Examiner

Evelyn A. Lester

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-130 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-15A)
- 6) ☐ Other: _____

EVELYN LESTER
PRIMARY EXAMINER

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 58-130 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of U.S. Patent No. 6,384,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention of the application is only a variation of the patented claimed invention.

The application claimed invention, having been amended beyond the originally filed claims (which were held to a restriction requirement), is an obvious variation of the invention disclosed and claimed in the patent. The application claimed invention is directed to a vending machine (i.e. claim 98) and/or an optical vend-sensing system (i.e. claim 78) having a dispensing unit and vend-

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space, as well as the optical vend-sensing system with an emitter and a detector, and a control mechanism, all of which are part of the patented claimed invention.

The variations in the claims are considered to be obvious, because though the patent disclosure may not be used as prior art, the disclosure may be used to answer obvious variation question because it is difficult to try and say what is an obvious variation of a claim. The disclosure sets forth at least one tangible embodiment within the claims, and is therefore less difficult and **more meaningful to judge whether the disclosed embodiment has been modified in an obvious manner**. Please note *In re Vogel and Vogel*, 164 USPQ 619-623 (CCPA 1970).

With respect to the present application, a variation includes, for example, that the vending machine specifically has a "transparent front." However, the patent claims, for example in claim 37, lines 2-5, indicate "upon selection by a customer." Since there are no specifics on how this is done, one of ordinary skill must consult the disclosure to ascertain the metes and bounds of this limitation. In so doing, one of ordinary skill would find that the selection made by a customer is accomplished by viewing the products through a glass (i.e. transparent) front (col. 5, lines 38-65) on the vending machine. Therefore, the application claimed invention is an obvious variation of the patent claimed invention.

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Response to Arguments

3. Applicant's arguments, see page 4, last paragraph of paper no. 13, filed 2-28-03, with respect to claims 98-103, 108 and 109 have been fully considered and are persuasive. The rejection of these claims based on the prior art of Muehlberger (U.S. patent 5,303,844) in view of Percy (U.S. patent 5,651,476) has been withdrawn.

Applicant's arguments filed 2-28-03 regarding the obviousness-type double patenting have been fully considered but they are not persuasive. As stated in the rejection above, the application claimed invention is an obvious variation of the patent claimed invention, even including the transparent front. Please note the rejection for explanation of this point. Therefore, the obviousness-type double patenting rejection is hereby maintained.

Conclusion

4. Applicant's amendment necessitated the additional explanation of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (703) 308-4943. The examiner can normally be reached on M- F, subject to I-flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703)308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Evelyn A. Lester
Primary Examiner
Art Unit 2873

August 11, 2003